

REMARKS

Claims 1-8 and 17-20 stand rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. Specifically, the Examiner asserts that the phrase “eccentricity correction data is recorded in a user data recording area in the same way as handling of the user data” is not enabled by the present Specification with respect to the “the same way” portion of the phrase. Applicants therefore traverse this rejection because the present Specification clearly enables one of ordinary skill in the art to practice the present invention with respect to these features of the claims.

For example, page 8 of the present Specification describes how conventional devices experience the undesirable drawback of having to provide additional special-purpose hardware to write eccentricity correction data separately from the user data. The same text of the Specification further recites how the present invention advantageously eliminates this conventional problem by dealing with the eccentricity correction data “in the same way as writing of user data.” (Page 8, lines 20-23, 24-27). The text goes on to further describe how “the same way” can be accomplished by utilizing the same device, the same write programs (page 8, line 29), and/or the same write procedure. (Page 8, line 37). The Examiner has not even asserted that any person of ordinary skill in the art would fail to understand the clear meaning of the cited phrase when it is read at least in light of these portions of the Specification. This understanding by one of ordinary skill was the standard the Examiner was required to apply for an enablement rejection.

The rest of the present Specification further describes the same claim terminology in such a way that one of ordinary skill in the art would clearly further understand how to make and use the present invention. Page 25 of the present Specification, for example, alternatively describes how the user data is written “in the normal way” (line 3), and how the eccentricity correction data is thus written in the “same way”. The Specification here describes how it can be easily determined that the correction data has been properly written, merely by determining if the data itself can be read out, since all of the data is written in the same way. The Examiner does not appear to have considered this portion of the Specification either in asserting the outstanding Section 112, first paragraph, rejection. Again, the Examiner does not assert that one of ordinary skill in the art would be unable to make and utilize the present invention according to these clear descriptions in the Specification. Accordingly, because the proper standard for establishing an enablement rejection has not been applied, the outstanding rejection should be withdrawn for at least these reasons.

Claims 1-8 and 17-20 also stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Specifically, the Examiner asserts that the same phrase from the claims discussed above, is also “vague and indefinite, because [the] claim language does not define what are the ways of handling the user data, and which way is the same.” Applicants therefore traverse this rejection as well for at least the reasons discussed above, and as follows.

As discussed above, the Specification clearly defines, to one of ordinary skill in the art, what is meant by the phrase “in the same way as handling of the user data.” With respect to the Examiner’s assertion that the claim language itself “does not define the ways of handling the user data,” Applicants remind the Examiner that this assertion is not the appropriate standard upon which a Section 112, second paragraph, rejection may be based.

Section 2173.02 of the MPEP instructs the Examiner to focus on whether a claim meets the threshold requirements of clarity and precision, and not whether more suitable language or modes of expression are available. The MPEP expressly directs the Examiner to “allow claims which define the patentable subject matter with a reasonable degree of particularity and distinctness.” (Emphasis in original). The “reasonable degree” threshold is met when “those skilled in the art would understand what is claimed when the claim is read in light of the Specification.” In the present case, however, the Examiner has not applied this test, nor has the Examiner asserted that one of ordinary skill in the art would not understand the metes and the bounds of the claim when read in light of any and all of the portions of the present Specification discussed above (and the rest of the Specification). Accordingly, because the appropriate test for indefiniteness has not been applied, and because the present Specification clearly defines the metes and bounds of the cited subject matter with a reasonable degree of particularity and distinctness, this Section 112 rejection should also be withdrawn.

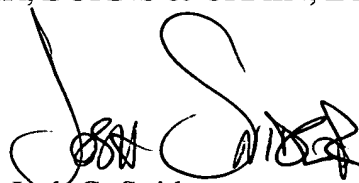
The Examiner will please note the amendments to the independent claims herein. Independent claims 1, 17, and 20 have been amended to restore the grammatical

format to these claims as they previously appeared. Claim 17 in particular has also been further amended to clarify that the claim is drawn toward a method of recording eccentricity correction data including a step of controlling the head position, as opposed to the previous version of the claim that was drawn more toward only a method of controlling the head position. The Examiner should find that none of these amendments to the claims give rise to any new substantive issues that require any further consideration or search. Entry of these amendments to the claims is respectfully requested.

For all of the foregoing reasons, Applicants submit that this Application, including claims 1-8 and 17-20, is in condition for allowance, which is respectfully requested. The Examiner is invited to contact the undersigned attorney if an interview would expedite prosecution.

Respectfully submitted,
GREER, BURNS & CRAIN, LTD.

By:

A handwritten signature in black ink, appearing to read "Josh C. Snider", is written over the printed name.

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